

RESPONSE TO THE OBJECTIONS

As note above, Applicants and their counsel are in compliance with the requirements of 37 CFR 1.56(a) and have filed that prior art which they believe to be material to the prosecution and patentability of this subject matter. Two IDS filings have been made.

All hyperlink notations have been cancelled from the specification as requested by the Examiner.

A proposed change to Figure 1 has been submitted with this amendment. Applicant has reviewed the figure 1 submitted with the application carefully, and the Figure definitely shows all numbered elements recited by the Examiner, except for element 17, which is merely an alternative for element 16. The PTO apparently may have a figure without numbers thereon. Applicants are therefore providing two copies of Figure 1. One copy shows the presence on the Counsel's copy of the Figure 1, with all numbers identified, except for the absent element 17. A second Figure 1 is provided showing the addition of element 17. Applicants, upon approval of this (these) corrections, will submit a Figure 1 with all numbers shown as in the copy of the Figure 1 having the handwritten notation "Proposed Change" thereon.

Applicant has again cancelled Figure 2 (Figures 2A and 2B) as showing a structure that is not material nor a best mode for practicing the invention, but is a crucible structure for holding metal.

CONCLUSION

Applicants through their counsel have addressed each and every issue raised in the Office Action. Upon approval of the proposed correction and issuance of a Notice of Allowance and Issue Fee Due, Applicants will submit the formal Figure 1 with the approved corrections.

Respectfully submitted,

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By Their Representatives,

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Date: 28 April 2004

By: 
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I hereby certify that this paper is being transmitted by facsimile to the United States Patent and Trademark Office on the date shown below.


Mark A. Litman

28 April 2004
Date



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[Home](#)[Index](#)[Search](#)[System Alerts](#)[eBusiness Center](#)[News & Notices](#)[Contact Us](#)

Manual of Patent Examining Procedure (MPEP)

[Go to MPEP - Table of Contents](#)

[browse before](#)

724.05 Petition To Expunge Information or Copy of Papers in Application File - 700 Examination of Applications

724.05 Petition To Expunge Information or Copy of Papers in Application File

I. INFORMATION SUBMITTED UNDER

MPEP § 724.02

A petition under 37 CFR 1.59(b) to expunge information submitted under MPEP § 724.02 will be entertained only if the petition fee (37 CFR 1.17(h)) is filed and the information has been found *not* to be important to a reasonable examiner in deciding on patentability. If the information is found to be important to a reasonable examiner in deciding on patentability, any petition to expunge the information will be denied. Any such petition to expunge information submitted under MPEP § 724.02 should be submitted at the time of filing the information under MPEP § 724.02 and directed to the Technology Center (TC) to which the application is assigned. Such petition must contain:

- (A) a clear identification of the information to be expunged without disclosure of the details thereof;
- (B) a clear statement that the information to be expunged is trade secret material, proprietary material, and/or subject to a protective order, and that the information has not been otherwise made public;
- (C) a commitment on the part of the petitioner to retain such information for the period of any patent with regard to which such information is submitted;
- (D) a statement that the petition to expunge is being submitted by, or on behalf of, the party in interest who originally submitted the information;
- (E) the fee as set forth in 37 CFR 1.17(i) for a petition under 37 CFR 1.59(b).

Any such petition to expunge should accompany the submission of the information and, in any event, must be submitted in sufficient time that it can be acted on prior to the date on which the patent or

reexamination certificate issues or the application becomes abandoned. The files of abandoned published applications are open to any member of the public for physical inspection (subject to the same conditions that apply to inspection of patented files). Timely submission of the petition is, accordingly, extremely important. If the petition does not accompany the information when it is initially submitted, the petition should be submitted while the application or reexamination is pending in the Technology Center (TC) and before it is transmitted to the Publishing Division. If, for any reason, a decision to expunge cannot be, or is not, made prior to the date on which the patent or reexamination certificate issues or the application becomes abandoned, any material then in the file will remain therein and be open to the public in accordance with 37 CFR 1.14. Accordingly, it is important that both the submission of any material under MPEP § 724.02 and the submission of any petition to expunge occur as early as possible during the examination process. The decision will be held in abeyance and be decided upon the close of prosecution on the merits.

II. INFORMATION UNINTENTIONALLY SUBMITTED IN APPLICATION

A petition to expunge information unintentionally submitted in an application (other than information forming part of the original disclosure) may be filed under 37 CFR 1.59(b), provided that:

- (A) the Office can effect such return prior to the issuance of any patent on the application in issue;
- (B) it is stated that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted;
- (C) the information has not otherwise been made public;
- (D) there is a commitment on the part of the petitioner to retain such information for the period of any patent with regard to which such information is submitted;
- (E) it is established to the satisfaction of the Commissioner that the information to be returned is not material information under 37 CFR 1.56; and
- (F) the petition fee as set forth in 37 CFR 1.17(h) is included.

A request to return information that has not been clearly identified as information that may be later subject to such a request by marking and placement in a separate sealed envelope or container shall be treated on a case-by-case basis. Applicants should note that unidentified information that is a trade secret, proprietary, or subject to a protective order that is submitted in an Information Disclosure Statement may inadvertently be placed in an Office prior art search file by the examiner due to the lack of such identification and may not be retrievable.

III. INFORMATION SUBMITTED IN INCORRECT APPLICATION

37 CFR 1.59(b) also covers the situation where an unintended heading has been placed on papers so that they are present in an incorrect application file. In such a situation, a petition should request return of the papers rather than transfer of the papers to the correct application file. The grant of such a petition will be governed by the factors enumerated in paragraph II of this section in regard to the unintentional submission of information. Where the Office can determine the correct application file that the papers were actually intended for, based on identifying information in the heading of the papers (e.g., application number, filing date, title of invention and inventor(s) name(s)), the Office will transfer the

papers to the correct application file for which they were intended without the need of a petition.

IV. INFORMATION FORMING PART OF THE ORIGINAL DISCLOSURE

A petition to expunge a part of the original disclosure must be filed under 37 CFR 1.183, since such a request requires a waiver of the requirements of 37 CFR 1.59(a). Petitions under 37 CFR 1.183 should be directed to the Office of Petitions. The petition must explain why justice requires waiver of the rules to permit the requested material to be expunged. It should be noted that petitions to expunge information which is a part of the original disclosure, such as the specification and drawings, will ordinarily not be favorably entertained. The original disclosures of applications are scanned for record keeping purposes. Accordingly, the grant of a petition to expunge information which is part of the original disclosure would require that the USPTO record of the originally filed application be changed, which may not be possible.

browse after

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[CONTACT US](#) | [PRIVACY STATEMENT](#)

[Go to MPEP - Table of Contents](#)



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[Home](#)[Index](#)[Search](#)[System Alerts](#)[eBusiness Center](#)[News & Notices](#)[Contact Us](#)**Manual of Patent Examining Procedure (MPEP)**

[Go to MPEP - Table of Contents](#)

[browse before](#)

724.06 Handling of Petitions to Expunge Information or Copy of Papers in Application File - 700 Examination of Applications

724.06 Handling of Petitions to Expunge Information or Copy of Papers in Application File

37 CFR 1.59 Expungement of information or copy of papers in application file.

(a)

(1) Information in an application will not be expunged and returned, except as provided in paragraph (b) of this section. See § 1.618 for return of unauthorized and improper papers in interferences.

(2) Information forming part of the original disclosure (*i.e.*, written specification including the claims, drawings, and any preliminary amendment specifically incorporated into an executed oath or declaration under §§ 1.63 and 1.175) will not be expunged from the application file.

(b) An applicant may request that the Office expunge and return information, other than what is excluded by paragraph (a)(2) of this section, by filing a petition under this paragraph. Any petition to expunge and return information from an application must include the fee set forth in § 1.17(h) and establish to the satisfaction of the Commissioner that the return of the information is appropriate.

37 CFR 1.59 provides that information, other than the original disclosure of the application, may be expunged from the file wrapper provided a petition to expunge under 37 CFR 1.59(b) and the required fee set forth in 37 CFR 1.17(h) are filed, and further that petitioner has established to the satisfaction of the Commissioner that the return of the information is appropriate. Return of information that was originally submitted to the Office under MPEP § 724.02 is appropriate when the petitioner complies with items (A)-(E) set forth in MPEP § 724.05, paragraph I, and the examiner or other appropriate Office official who is responsible for considering the information has determined that the information is not important to a

reasonable examiner in deciding whether to allow the application (i.e., the information is not material to patentability). Return of information that was inadvertently submitted to the Office is appropriate provided that items (A)-(F) set forth in MPEP § 724.05, paragraph II, are satisfied. See also MPEP § 724.

Where the information to be expunged was not submitted pursuant to MPEP § 724.02 or as part of an Information Disclosure Statement, the petition should be sent to the Office of Petitions for decision.

The decision on the petition to expunge should be held in abeyance until the application is allowed or an *Ex parte Quayle* action, or a Notice of Abandonment is mailed, at which time the petition will be decided. However, where it is clear that the information was submitted in the wrong application, then the decision on the petition should not be held in abeyance. See MPEP § 724.05, paragraph III. In a pending application that has not been allowed or in which an *Ex parte Quayle* action has not been mailed, the examiner may not have finally considered what is material to a decision of patentability of the claims. Petitioner may be notified that the decision on the petition under 37 CFR 1.59(b) to expunge information in an application will be held in abeyance and be decided upon allowance of the application, or the mailing of an *Ex parte Quayle* action or a Notice of Abandonment using form paragraph 7.204.

¶ fp7.204 Petition Under 37 CFR 1.59(b) To Expunge Information: Decision Held in Abeyance

Paper No. [1]

In re Application of [2]

:

Appl. No.: [3]

: RESPONSE TO PETITION

Filed: [4]

: UNDER 37 CFR 1.59

For: [5]

:

This is a response to the petition under 37 CFR 1.59(b), filed [6], to expunge information from the above identified application.

The decision on the petition will be held in abeyance until allowance of the application or mailing of an *Ex parte Quayle* action or a Notice of Abandonment, at which time the petition will be decided.

Petitioner requests that a document entitled [7], filed [8], be expunged from the record. Petitioner states either: (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR 1.17(h) has been paid.

The decision on the petition is held in abeyance because prosecution on the merits is not closed. Accordingly, it is not appropriate to make a final determination of whether or not the material requested to be expunged is "material," with "materiality" being defined as any information which the examiner considers as being important to a determination of patentability of the claims. Thus, the decision on the petition to expunge must be held in abeyance at this time.

During prosecution on the merits, the examiner will determine whether or not the identified document is considered to be "material." If the information is not considered by the examiner to be material, the information will be returned to applicant.

Examiner Note

1. A Technology Center Director decides this petition only if the information was submitted pursuant to MPEP § 724.02.

2. The petition should be sent to the Office of Petitions for decision if:

the information was not submitted pursuant to MPEP § 724.02. Information which is part of the original disclosure (specification including any claims, drawings, and any preliminary amendment referred to in the oath or declaration) cannot be expunged under 37 CFR 1.59. Some papers entered into the application file, e.g., arguments made in an amendment, may be expunged under appropriate circumstance, however, the petition should be sent to the Office of Petitions for decision; or

the petition is also accompanied by a petition under 37 CFR 1.183 requesting waiver of one of the requirements explicitly set forth in 37 CFR 1.59 (e.g., requesting expungement of part of the original disclosure).

3. This decision is printed with the USPTO letterhead.

4. In bracket 7, clearly identify the document which petitioner requests to expunge. For example, refer to the author and title of the document.

5. Mail with PTO-90C cover sheet.

When an application has been allowed, an *Ex parte Quayle* action has been mailed, or an application is abandoned, a petition to expunge should be decided by a TC Director (see MPEP § 1002.02(c)). At this time a determination must be made as to whether the information in question is material. Form paragraph 7.205 should be used to grant a petition to expunge, whereas form paragraphs 7.206 - 7.213 should be used to dismiss such a petition.

¶ fp7.205 Petition Under 37 CFR 1.59(b) To Expunge Information Granted

Paper No. [1]

In re Application of [2]

:

Appl. No.: [3]

: DECISION ON PETITION

Filed: [4]

: UNDER 37 CFR 1.59

For: [5]

:

This is a decision on the petition under 37 CFR 1.59(b), filed [6], to expunge information from the above identified application.

The petition is granted.

Petitioner requests that a document entitled [7], filed [8], be expunged from the record. Petitioner states that either (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR 1.17(h) has been paid.

The information in question has been determined by the undersigned to not be material to the examination of the instant application.

Applicant is required to retain the expunged material(s) for the life of any patent which issues on the above-identified application.

The expunged material is returned herewith.

Enclosure: [9]

Examiner Note

1. A Technology Center Director decides this petition only if the information was submitted pursuant to MPEP § 724.02. Furthermore, a petition to expunge may not be granted unless the application has been allowed or is abandoned, or an *Ex Parte Quayle* action has been mailed.

2. The petition should be sent to the Office of Petitions for decision if:

the information was not submitted pursuant to MPEP § 724.02. Information which is part of the original disclosure (specification including any claims, drawings, and any preliminary amendment referred to in the oath or declaration) cannot be expunged under 37 CFR 1.59. Some papers entered into the application file, e.g., arguments made in an amendment, may be expunged under appropriate circumstance, however, the petition should be sent to the Office of Petitions for decision; or

the petition is also accompanied by a petition under 37 CFR 1.183 requesting waiver of one of the

requirements explicitly set forth in 37 CFR 1.59 (e.g., requesting expungement of part of the original disclosure).

3. This decision is printed with the USPTO letterhead.

4. In brackets 7 and 9, clearly identify the expunged document. For example, refer to the author and title of the document.

5. Mail with PTO-90C cover sheet.

¶ 7.206 Petition Under 37 CFR 1.59(b) To Expunge Information Dismissed

Paper No. [1]

In re Application of [2]

:

Appl. No.: [3]

: DECISION ON PETITION

Filed: [4]

: UNDER 37 CFR 1.59

For: [5]

:

This is a decision on the petition under 37 CFR 1.59(b), filed [6], to expunge information from the above identified application.

The petition is dismissed.

Petitioner requests that a document entitled [7], filed [8], be expunged from the record.

"Materiality" is defined as any information which the examiner considers as being important to a determination of patentability of the claims.

The petition is deficient because:

Examiner Note

1. A Technology Center Director decides this petition only if the information was submitted pursuant to MPEP § 724.02. However, the petition should not be granted until the application has been allowed or abandoned, or an *Ex parte Quayle* action has been mailed.

2. The petition should be sent to the Office of Petitions for decision if:

the information was not submitted pursuant to MPEP § 724.02. Information which is part of the original disclosure (specification including any claims, drawings, and any preliminary amendment referred to in the oath or declaration) cannot be expunged under 37 CFR 1.59. Some papers entered into the application file, e.g., arguments made in an amendment, may be expunged under appropriate circumstance, however, the petition should be sent to the Office of Petitions for decision; or

the petition is also accompanied by a petition under 37 CFR 1.183 requesting waiver of one of the requirements explicitly set forth in 37 CFR 1.59 (e.g., requesting expungement of part of the original disclosure).

3. This decision is printed with the USPTO letterhead.

4. In bracket 7, clearly identify the document which petitioner requests to expunge. For example, refer to the author and title of the document.

5. This form paragraph must be followed with one or more of form paragraphs 7.207, 7.208, and 7.209.

¶ fp7.207 Petition To Expunge, Conclusion, Lacks Fee

the petition was not accompanied by the required fee under 37 CFR 1.17(h).

¶ fp7.208 Petition to Expunge, Conclusion, Material to Determination of Patentability

the information that petitioner requests to expunge is considered to be material to the determination of patentability because [1].

Examiner Note

In bracket 1, provide an explanation of basis for conclusion that information is material to the determination of patentability.

¶ fp7.209 Petition To Expunge, Conclusion, Information Made Public

the information has been made public. [1]

Examiner Note

In bracket 1, provide explanation of basis for conclusion that information has been made public.

¶ fp7.210 Petition to Expunge, Conclusion, No Commitment to Retain Information

the petition does not contain a commitment on the part of petitioner to retain the information to be expunged for the period of any patent with regard to which such information is submitted.

¶ fp7.211 Petition to Expunge, Conclusion, No Clear Statement That Information is Trade Secret, Proprietary, and/or Subject to Protective Order, or that Submission Was Unintentional

the petition does not contain a clear statement that the information requested to be expunged is either: (1) a trade secret, proprietary, and/or subject to a protective order; or (2) was unintentionally submitted and failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted. [1]

Examiner Note

In bracket 1, indicate whether any such statement was provided and, if so, explain why such statement is not clear.

¶ fp7.212 Petition to Expunge, Conclusion, No Clear Identification of Information to be Expunged

the petition does not clearly identify the information requested to be expunged. [1]

Examiner Note

In bracket 1, explain why the identification of the information requested to be expunged is not clear.

¶ fp7.213 Petition to Expunge, Conclusion, No Statement That Petition Is Submitted By, or on Behalf of, Party in Interest Who Originally Submitted the Information

the petition does not contain a statement that the petition is being submitted by, or on behalf of, the party in interest who originally submitted the information.

**HOME | INDEX | SEARCH | SYSTEM STATUS | BUSINESS CENTER | NEWS&NOTICES |
CONTACT US | PRIVACY STATEMENT**

Go to MPEP - Table of Contents